

REMARKS

Applicant has carefully reviewed the Office Action of February 9, 2005, and offers the following remarks to accompany the amendments presented above. Applicant appreciates the telephonic interview of April 28, 2005. Where appropriate, remarks from the interview are included below, and these remarks are intended to serve as the Interview Summary if such is required.

Before addressing the rejections, Applicant provides a brief summary of the present invention, so that the remarks relating to the rejections are considered in the proper context. The present invention is designed to facilitate a client in a private network being alerted to the fact that its public address, as assigned by an address translation device, has changed. To this end, the present invention requires devices that are communicating with the client to replicate the public address. The first version of the public address is in the header of the packet from the device, and the second version of the public address is in the message part of the packet. When the packet reaches the address translation device, the address translation device changes the public address in the header to the private address, and then forwards the packet to the client over the private network. The client receives the packet, and then compares the public address embedded in the message portion of the packet to a public address previously stored in the client. If the public address embedded in the message is different from the stored public address, then the client infers that the address translation device has changed the client's public address, and may take appropriate action. Implicit in this arrangement is that the client is within a private network, presumably for security reasons, and is not intended to have its own public address or be "reached" without passing through the address translation device.

Claims 1-5 and 8-20 were rejected under 35 U.S.C. § 103 as being unpatentable over Bhatia et al. (hereinafter "Bhatia") in view of Gervais et al. (hereinafter "Gervais"). Applicant respectfully traverses. For the Patent Office to combine references in an obviousness rejection, the Patent Office must do two things. First, the Patent Office must articulate a motivation to combine the references, and second, the Patent Office must support the articulated motivation with actual evidence. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). Once a proper combination has been made, to establish *prima facie* obviousness, the combination must still teach or suggest all the claim elements. MPEP § 2143.03.

Applicant initially traverses the rejection based on the combination of Bhatia and Gervais because the Patent Office has not properly supported the motivation to combine the references. Specifically, the Patent Office asserts that the motivation to combine the references is "because both inventions teach of using address translation from a private to a public address. Furthermore, the teachings of Gervais to include a modem with the workstation would allow the workstation to be provided with a unique public address." This asserted motivation lacks the requisite evidence in support thereof. Since there is no evidence to support the motivation, the motivation is improper. Since the motivation is improper, the combination is improper. Since the combination is improper, the rejection is improper. Applicant requests withdrawal of the § 103 rejection of claims 1-5 and 8-20 at this time on this basis.

Even if the combination is proper, a point which Applicant does not concede, the combination does not establish obviousness. Specifically, claim 1 recites "receiving a message over the private network from the public network via the address translation device, the message having the public address of the client as provided by the address translation device. . . ." The Patent Office asserts that the combination of Bhatia and Gervais teaches this element since Bhatia teaches an LAN modem address translation device receiving messages with public addresses therein, and Gervais teaches that client devices can have LAN modems. This combination merges the address translation device with the client. Initially, Applicant notes that this combination vitiates the purpose of the private network and the firewall function provided by the address translation device, since it combines the client into the address translation device. Furthermore, the claim requires that the recipient of the message be distinct from the address translation device. During the telephonic interview, Applicant explained the distinct nature of the client and the address translation device. The Primary Examiner, who did not have the benefit of having a copy of the claims during the interview, opined that it was not clear what element was doing the "receiving" of claim 1. As Applicant argued during the telephonic interview, the precise recipient is not material. The claim recites "receiving over the private network. . . ." The Patent Office's construction that merges the client with the address translation device effectively removes the private network from the client because if the address translation device is the client, then the address translation device does not receive over the private network. Claim 1 continues, stating: "from the public network via the address translation device. . . ." Since the claim recites that the receiving is via the address translation device, there

has to be a second element, distinct from the address translation device that is receiving. During the telephonic interview, the Primary Examiner admitted that conceptually the invention was different than the combination of references, but was unable, in the absence of reading the specific claim language, to conclude that the claim language specifically defined thereover. As the Primary Examiner did not have the precise claim language in front of him during the telephonic interview, Applicant respectfully opines that this explanation is sufficient to show how the claim language without amendment defines over the rejection of record.

During the telephonic interview, the Primary Examiner opined that if Applicant could clarify what element was receiving the message with the public address, that this would most likely overcome the rejection. New claim 21 defines that the client is receiving the message over the private network. Support for this can be found in Figure 2A of the application as filed. No new matter is added. As the client is explicitly distinct from the address translation device, claim 21 overcomes the rejection of record.

During the telephonic interview, the Primary Examiner also opined that if the replication of the public address could be better explained, this replication would overcome the rejection. New claim 22 recites the replication of the public address prior to translation. Support for this can be found in Figure 2A, element 104 of the application as filed. No new matter is added. Since claim 22 recites the replication of the public address, claim 22 overcomes the rejection of record.

Claims 2-5 and 8-12 depend from claim 1, and are patentable at least for the same reasons. Applicant requests withdrawal of the § 103 rejection of claims 1-5 and 8-12 at this time for this reason as well.

Claim 13 recites a client with a control system that receives a message over the private network from the public network via the address translation device. As explained above with respect to claim 1, the combination of Bhatia and Gervais does not teach such a client. Further, in light of the Primary Examiner's comment about clarifying the nature of what is receiving, claim 13 already recites that the client is receiving the message. To this extent, it is clear that the client is distinct from the address translation device, and the combination of Bhatia and Gervais does not show this element. Since the combination does not teach or suggest this element, the combination does not establish obviousness, and claim 13 is allowable.

Claims 14-16 depend from claim 13, and are allowable at least for the same reasons that claim 13 is allowable. Applicant requests withdrawal of the § 103 rejection of claims 13-16 at this time for this reason as well.

Claim 17 recites, in relevant part, essentially the same element as claim 1. As explained above, the combination of Bhatia and Gervais does not teach or suggest this element. Since the combination does not teach or suggest this element, the combination does not establish obviousness, and claim 17 is allowable for this reason as well. Claims 18-20 depend from allowable claim 17, and are allowable for at least the same reasons. Applicant requests withdrawal of the § 103 rejection of claims 17-20 at this time for this reason as well.

Claims 6 and 7 were rejected under 35 U.S.C. § 103 as being unpatentable over Bhatia and Gervais and in view of Kennedy et al. (hereinafter "Kennedy"). Applicant respectfully traverses. The standard for establishing obviousness is set forth above.

Applicant initially traverses the rejection because the Patent Office has not properly supported the motivation to combine the references. In particular, the Patent Office opines that the motivation would be "because both inventions deal with using a network address translator and establishing a session to communicate with devices on the public network. Furthermore, the teachings of Kennedy to use a Session Initiation Protocol improves Bhatia's invention by providing capabilities such as call forwarding, call signaling, call holding and caller ID." This asserted motivation lacks any evidence in support thereof. Since the motivation lacks the requisite actual evidence, the motivation is improper. Since the motivation is improper, the combination is improper. Since the combination is improper, the rejection is improper. Since the rejection is improper, Applicant requests withdrawal of the § 103 rejection of claims 6 and 7 at this time.

Applicant further traverses the rejection because the addition of Kennedy does not cure the underlying deficiencies of the combination of Bhatia and Gervais. That is, the Patent Office has not identified where in Kennedy there is a teaching or suggestion that the client is distinct from the address translation device and receives the message with the public address therein, as recited in the claims. Since the references individually do not teach or suggest this element, the combination of references cannot teach or suggest the claim element. Since the combination does not teach or suggest the claim element, the combination does not establish obviousness.

Since the combination does not establish obviousness, claims 6 and 7 are patentable. Applicant requests withdrawal of the § 103 rejection of claims 6 and 7 for this reason as well.

Applicant requests reconsideration of the rejections in light of the amendments and remarks presented herein. Applicant earnestly solicits claim allowance at the Examiner's earliest convenience.

Respectfully submitted,

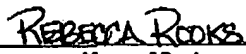
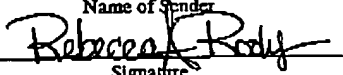
WITHROW & TERRANOVA, P.L.L.C.

By: 

Benjamin S. Withrow
Registration No. 40,876
P.O. Box 1287
Cary, NC 27512
Telephone: (919) 654-4520

Date: May 9, 2005

Attorney Docket: 7000-109

CERTIFICATE OF TRANSMISSION		
I HEREBY CERTIFY THAT THIS DOCUMENT IS BEING TRANSMITTED VIA FACSIMILE ON THE DATE INDICATED BELOW TO:		
Examiner: <u>Joe Joshua</u>	Art Unit: <u>2154</u>	Fax: <u>703-872-9306</u>
 Name of Sender		
 Signature		
<u>5/9/05</u> Date of Transmission		